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10/507,406	04/08/2005	Georg Frohlich	P04,0353	6881
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SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			EXAMINER MAI, THIEN T	
			ART UNIT	PAPER NUMBER
			2876	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/507,406

Applicant(s)

FROHLICH ET AL.

Examiner

Thien T. Mai

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2007.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 51-78 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 02/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Acknowledgements***

Applicant's amendment filed on 03/01/2007 is hereby acknowledged.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 65 is rejected because it is unclear as to whether the unique identifier is even programmed in the document. Claim 65 recites "said transponder having an electronic storage region for storing said unique identifier..." which appears to be a functional limitation which then causes the step of "reading said unique identification from said transponder ..." defective since the identifier is not written.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim(s) 51, 56-69, 71-76, 78 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger et al. (20030063139) in view of Ahstrom et al. (US 6,222,452)

Hohberger discloses a method for production of a printed document with a unique identifier, comprising the steps of:

providing a file (par 110-111 discusses the member files in card member database 314) with information to be printed on the printed document;

providing on a recording medium a transponder (paragraphs 0110-111), said transponder being capable of being electronically read without contact (paragraph 0009), and

printing said information from said file onto said recording medium to create said printed document (Fig. 19 shows a post card printing process); reading said unique identifier (paragraph 102 mentions a prospect having unique identification; Fig. 18 and paragraph 106 discusses a card number uniquely identifying the customer on the printed document) from said transponder after said printing (paragraph 0106, 121) and

linking said unique identifier read from said transponder in said file with said information printed on said recording medium forming said printed document (paragraph 0122 mentions on-demand printing on the transponder that is tied to the target and the stored information; the target being the target address and customer information 206 in Fig. 17A and 250 in Fig. 18; see also paragraph 0102).

Hohberger is silent with respect to the file not having said unique id prior to a printing of said information on said document.

Ahlstrom et al. discloses a document in the form of a luggage tag 22 pre-manufactured with RFID antenna/chip from a roll (Fig. 5). The data can be written to RFID chip in a read-only fashion and is inherently does not have a unique ID of a passenger until it is programmed (see also col. 7 lines 20+, col. 8 lines 1+)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Ahstrom et al. in order to eliminate the need for mechanism in a printer to apply separate RFID labels thus reducing production time and potential maintenance time in case the label applicator in the printing apparatus is defective.

Re claim 61, Hohberger discloses a method of claim 51 wherein the unchangeable identifier refers to goods and said information printed on the recording medium refers to said goods (paragraphs 0002-0003 describes the invention is applied to media including shipping document, which inherently known in the art for having at least information associated with goods printed on the documents).

Re claim 62, Hohberger discloses a method of claim 51 wherein said unchangeable identifier is stored in an encrypted fashion in the transponder (paragraphs 0009, 11, 35, 36, 61, 82, 111, 128, 130 mentions RFID being encoded)

Re claim 63, Hohberger discloses a method of claim 51 wherein said printing of said information on said recording medium is by use of an electrophotographic print device (claim 60).

Re claim 64, Hohberger discloses a method of claim 51 wherein said transponder is capable of being electronically written without contact (paragraph 52 describes shown in FIG. 5, printer 48 includes utilizes an RF signal 108 that is emitted by transponder programmer antenna 110 to program the memory in RFID integrated circuit 44)

3. Claim(s) 52-53, 70, 77 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger et al. (20030063139) modified by Ahstrom et al. (US 6,222,452) further in view of Funk et al. (US 6,269,169)

Hohberger/Ahstrom discloses all limitations, as set forth in the claim(s) and discussed above, except

Hohberger/Ahstrom is silent with respect to file is used to check validity of the document wherein the information printed on the document is checked against the unique identifier read from the transponder and the file is used to check a printing error in the document.

Funk et al. disclose magnetic or RFID (col. 1 lines 30-40) printed document in FIG. 1 is shown a block diagram of the novel secure document reader verifier 10. Reader verifier 10 has a slot or opening 12 therein into which at least a portion of a document 11 is inserted. The size and shape of opening 12 may be changed to accommodate different types of identification documents and documents of value. An example of such a document 11 is a passport, on the inside of which is located a photograph, bibliographic and possibly other information about the bearer of the passport. This information includes passport number, issuance and expiration dates, issuing authority, biometric information about the person to whom the passport 11 is issued, and other information. (col. 3 lines 34-45).

The novel document reader verifier disclosed herein can also read photographic and other information, which may include encoded biometric information of fingerprints, voice prints, and eyeprints, recorded on a passport or other document,

Art Unit: 2876

and then compare these to information stored in data bases or to the bearer of the passport or other document. Such biometric information can be encrypted and stored in two dimensional bar codes on identity documents. The novel document reader verifier can compare in real time such biometric information recorded on a passport or other document with the output of readers, such as fingerprint and eye readers separate from but connected to the novel reader verifier described and claimed herein, taken at the time when a passport or other document is being read and verified to authenticate that the document is being carried or presented by the person to whom it was issued (col. 2 lines 39-55)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Funk et al. in order to ensure the data printed and encoded on the document are correct data, thus preventing unscrupulous individual from stealing the data for profits or stealing of identity when it is sent to the individual.

4. Claim(s) 54-55 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohberger et al. (20030063139) modified by Ahstrom et al. (US 6,222,452) further in view of Veitch (7,091,864)

Hohberger/Ahstrom discloses all limitations, as set forth in the claim(s) and discussed above, except

Hohberger/Ahstrom does not disclose additional data is written to the transponder in addition to the identifier

**Veitch** et al. discloses an RFID tag having a memory structure which allows for large amounts of information to be stored thereon. The memory structure can be arranged such that parts of the memory are read-only (that is unchangeable), other parts are read/write and further parts are encrypted and password protectable (col. 1 lines 55-65)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Veitch to those of Hohberger in order for the information stored in the RFID memory to be retrieved, in case the RFID memory's re-writable portion is inadvertently altered or erased, from a different database that has the same information stored on the RFID memory

#### ***Remarks***

5. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection. Applicants' contention on newly added limitations being novel over prior art; however, an updated search shows that prior art can still meet the limitations.

6. In response to Applicant's remarks that Hohberger/Ahstrom does not provide the linking, it is respectfully submitted that when printing information on the document using the file, it is interpreted as the act of linking the file and the printed information since they represent the same information. To distinguish from Hohberger/Ahstrom, Applicant is respectfully request to provide further details as to how the linking differed from prior art.

#### ***Conclusion***



**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Thien T Mai  
Examiner  
Art Unit 2876

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May 07

  
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